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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/796,490

03/04/2004

Mark Lykam

3043

36822 7590 04/17/2008

GORDON & JACOBSON, P.C.
60 LONG RIDGE ROAD
SUITE 407
STAMFORD, CT 06902

EXAMINER

ALIE, GHASSEM

ART UNIT

PAPER NUMBER

3724

MAIL DATE

DELIVERY MODE

04/17/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/796,490	Applicant(s) LYKAM, MARK	
	Examiner GHASSEM ALIE	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01/28/08.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 1-8 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9 and 11-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 October 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/16/06</u> . | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. Applicant's election with traverse of Group II (claims 9-13) and Subgroup (11-13) in a reply filed on 01/28/08 is acknowledged. The traversal is on the ground(s) that inventions in Groups I-II are not properly classified and they should be classified under same subclass and examined all together. Applicant asserts that the Examiner may not have accurately classified each one of Groups I-II. Firstly, each one of individual inventions in Groups I-II has distinct features distinctive from the other invention. See the restriction requirement mailed on 12/26/07. Each individual invention with distinct features has a separate status in the art and naturally requires a different field of search. It should be noted, "for purpose of the initial requirement a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search defined in MPEP § 808.2." As discussed above, the Examiner has shown that each individual distinct invention in Groups I-II has a separate status in the art and a different field of search. Therefore, there is a serious burden on the Examiner to examine distinct individual inventions in Groups I-II together. Secondly, applicant assertion that each individual group may not have accurately classified is not persuasive. Examiner knows that each of the individual distinct invention belongs to a different class and subclass. Examiner also knows how to classify each individual and distinct invention. In addition, the class and the subclass correspond to each individual distinct invention of Groups I-II are not the only class and subclass that will be searched. It should be noted that the Examiner searches different subclasses and even classes with respect to each distinct invention. As stated above, each individual invention in Groups I-II has a

separate status in the art and a separate filed of search. The Search for each individual invention in Groups I-II may overlap with each other but they do not coincide identically throughout.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-8 and 10 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, a cutting blade as set forth in claim 1; a Geneva Wheel as set forth in claims 10 and 14; top walls overlying the angled centering walls as set forth in claim 12; and a pair of torsion springs which bias the pill against the centering wall as set forth in claim 13 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.
4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "2" has been used to designate both a plunger and a switch. See Fig.
5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: "3."

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing

should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

6. The specification is objected to under 37 CFR 1.71 because it is not clear how the self centering pharmaceutical pill functions and cut different pill sizes. The specification fails to teach how the components of the self centering pharmaceutical pill are related to one another or how these components function individually or with other components. The specification fails to disclose what encompasses an indexing wheel, torsion fingers, vibration pads and etc. The specification also fails to teach what make the pill cutting device “a self centering pharmaceutical pill cutting g device.” It is not clear how the indexing wheel is adjustable. It is not clear how the torsion fingers center keep the pill at center before cutting. It is not clear what is the function of the left and right torsion fingers and how these fingers work. The specification fails to teach how the torsion fingers spring back and what the torsion fingers need to spring back. The specification fails to teach how the indexing wheel holds the pill down. The specification fails to teach how the indexing wheel accommodate

multiple pill sizes without change of wheel itself. The structure of the indexing wheel is not disclosed. The specification fails to teach how the indexing wheel can be configured in different shaped pills. The specification also fails to teach how the solenoid activates the blade up and down and how the pills ranging up to 0.187 inch thickness and 0.500 inch diameter can be cut by the pill cutting device. The original specification also fails to teach how the vibration pads work and what is the purpose of having vibration pads within the indexing wheel. The original specification fails to teach that how the pills are held or positioned in the pill receiving locations. The original specification also fails to teach a Geneva wheel. The original specification fails to teach how the pills are hold down in the place upon cutting by the cutting blade. The original specification also fails to teach how the pair of torsion fingers bias the pill against the centering walls. In fact, the original disclosure fails to disclose central walls. The original specification fails to teach where the central walls, torsion springs, and top walls are located and how they work together.

7. The amendment filed 10/10/06 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: paragraphs 0005-0008, 0014-0019 and amendment to Figs. 1-2 introduce new matter to the original disclosure. Paragraphs 0005-0008, 0014-0019 contains the objective of the invention which is not disclosed in the original disclosure; and the detail description of the drawings 1-2 and the invention in a manner that is not disclosed at all in the original discourse. The amended specification also discloses that the indexing means is a well known Geneva wheel. This has not been disclosed in the

original disclosure. Applicant asserts that by looking at the Fig. 2 a person of ordinary skill in the art concludes that the indexing wheel in a Geneva Wheel. This is not true. The original disclosure does not define a Geneva wheel and describe how a Geneva wheel functions. Merely, by looking at a wheel in Fig. 2, one cannot conclude that the wheel is a Geneva wheel. In addition, Fig. 1, now shows a blade 6 which is not disclosed in the original disclosure. In other words, the shape, type, location, and size of the blade 16 in amended Fig. 1 is not disclosed in the original disclosure. Furthermore, the original disclosure does not teach that the element 14a in the amended Fig. 2 is a “driven wheel” of a “Geneva drive.” The original disclosure does not disclose a driven wheel at all. The relationship between different members including wheels and torsion fingers is not disclosed in the original disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 9-14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which is not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Regarding claims 9-14, the disclosure fails to teach what are the components of the apparatus for cutting pills or how the apparatus for cutting pills functions. The disclosure fails to disclose what encompasses an indexing wheel, torsion fingers, vibration pads and etc.

Regarding claim 9, the original specification fails to teach that how the pills are held or positioned in the pill receiving locations. Regarding claim 12, the original specification fails to teach how the pills are hold down in the place upon cutting by the cutting blade. Regarding claim 13, the original specification also fails to teach how the pair of torsion fingers bias the pill against the centering walls. In fact, the original disclosure fails to disclose central walls. The original specification fails to teach where the central walls, torsion springs, and top walls are located and how they work together.

10. Claims 9-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding claim 9, the original specification fails to teach that how the pills are held or positioned in the pill receiving locations. Regarding claims 10 and 14; the original specification also fails to teach a Geneva wheel. Regarding claim 12, the original specification fails to teach how the pills are hold down in the place upon cutting by the cutting blade. Regarding claim 13, the original specification also fails to teach how the pair of torsion fingers bias the pill against the centering walls. In fact, the original disclosure fails to disclose central walls. The original specification fails to teach where the central walls, torsion springs, and top walls are located and how they work together.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 9 and 14, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Brawne et al. (4,565,053), hereinafter Brawne. Regarding claim 1, Browne teaches an apparatus capable of cutting pills. Brawne teaches that the apparatus includes a cutting blade 17; and an indexing wheel assembly arranged below the cutting blade, the indexing wheel assembly includes a plate 25 having a plurality of pill receiving locations. It should be noted that the different locations around the indexing wheel could be used for receiving a plurality of pills. See Fig. 1 in Brawne. Brawne also teaches an indexing means “M” for causing the plate 25 to repeatedly rotate and stop the pill receiving locations in a position under the cutting blade, where the cutting blade moves in a plane perpendicular to the plate in order to cut pills located in the pill locations and stopped under the cutting blade. See col. 1, lines 51-68 in Brawne. It should be noted that the pills could be placed on the slots or in the slots in the indexing wheel 25 which receive the cutting edge of the blade 17.

Regarding claim 14, Brawne teaches everything noted above including that the wheel is a Geneva wheel.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 11-13, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Brawne. Regarding claims 11-13, Brawne teaches everything noted above including that the indexing wheel includes grooves. Brawne does not explicitly teach the each cutting grooves is flanked by angled centering wall; the plate includes top walls overlying the angled centering walls to hold the pills down in the place upon cutting by the cutting blade; and a pair of torsion fingers arranged below the cutting blade such that when the indexing wheel brings a pill into position for cutting, the torsion fingers bias the pill against the centering walls. However, Official Notice is taken that the use of the cutting grooves being flanked by centering walls, top wall overlying the centering walls, and torsion springs for holding a workpiece is well known in the art.

Response to Arguments

15. Applicant's arguments with respect to claims 9-14 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Leopoldi et al. (4,173,826), Yuyama et al. (6,050,064), Endo et al. (5,044,239), Eric (2003/0084574), Daniels (3,518,908), and Deckert (4,199,863) teach pill cutter having pill holders.

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ghassem Alie whose telephone number is (571) 272-4501. The examiner can normally be reached on Mon-Fri 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on (571) 272-4502. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, SEE <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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GA/ga

April 14, 2008

/Ghassem Alic/

Primary Examiner, Art Unit 3724